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In re Application of
Yamasaki et al.
Application No.: 09/869,101
PCT No.: PCT/JP99/07222
Int. Filing Date: 22 December 1999
Priority Date: 24 December 1998
Attorney's Docket No.: 06501-082001
For: BENZIMIDAZOLE DERIVATIVES

DECISION ON

REQUEST UNDER

37 CFR 1.42

This is a decision on the papers filed 06 December 2001 which are being treated as a request under 37 CFR 1.42.

BACKGROUND

On 22 December 1999, applicants filed international application PCT/JP99/07222, which claimed priority of an earlier Japanese application filed 24 December 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 06 July 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 09 June 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 June 2001.

On 22 June 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 06 September 2001, the Office

ADDITIONAL INFORMATION

As indicated by the Office (DOFO USE ONLY), PCT DOFO 06 September 2001, that applicant was required to file an oath declaration and a surcharge fee.

On 06 December 2001, applicants filed the current response which included an executed declaration for inventors Yamasaki, Imoto, Hiramura, Kawauchi, Kayakiri, Sawada, Abe, Hamashima, Ishibashi and Setoi. Applicants also included a second declaration executed by Noriko Uku, Chikako Oku and Tomohito Oku as representatives of Teruo Oku.

On 26 February 2001, applicants filed the current response indicating that the Declaration submitted on January 12, 2001 does comply with 37 CFR 1.63 since an Initial Application Data Sheet was also submitted.

DISCUSSION

Applicant's declarations are being treated as a request under 37 CFR 1.42.

With respect to applicants' declarations in the current application, 37 CFR 1.42 states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497 states, in part:

- (a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to 1.494 or 1.495, he or she must file an oath or declaration that:
 - (1) Is executed in accordance with either 1.66 or 1.68;
 - (2) Identifies the specification to which it is directed;
 - (3) Identifies each inventor and the country of citizenship of each inventor; and
 - (4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
- (b) (1) The oath or declaration must be made by all of the actual inventors except as provided for in 1.42, 1.43 or 1.47.
- (2) If the person making the oath or declaration is not the

inventor, the oath or declaration must state: "I, _____, declare that I am the legal representative of the inventor, and that the inventor would have been required to state: "If the person signing the oath or declaration is the legal

representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.


The declarations filed 06 December 2001 fail to properly identify the citizenship, residence and mailing address of both the legal representatives and the deceased inventor. Accordingly, the declaration is not acceptable under 37 CFR 1.497.

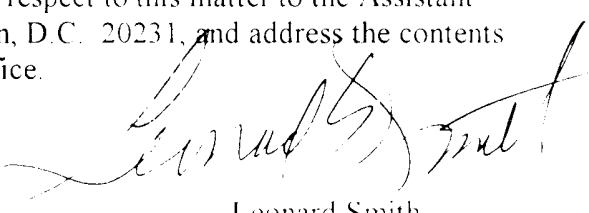
CONCLUSION

Applicants' request under 37 CFR 1.42 is **DISMISSED** without prejudice

If reconsideration of this decision is desired, a proper response, i.e., a declaration in compliance with 37 CFR 1.497(a)-(b), must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a). **FAILURE TO RESPOND WITH RESULT IN ABANDONMENT OF THE APPLICATION.**

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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